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09/890,706	10/25/2001	Peter Lauer	22750/493	6149

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EXAMINER

STASHICK, ANTHONY D

ART UNIT

PAPER NUMBER

3728

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/890,706

Applicant(s)

Lauer et al.

Examiner

Anthony D. Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-13, 15, 17-22 and 24-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-13, 15, 17-22 and 24-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 23 April 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

DETAILED ACTION

*Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 11-14, 16, 20-24 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over the French reference to Decathlon Production 560,698 (Decathlon '698) in view of Kiyosawa 4,878,301. Decathlon '698 discloses all the limitations substantially as claimed including the following: an outsole 25; an upper (see Figures 1 and 2); the outsole having a contraction (that shown in Figure 3 where the section IV is shown) extending into a first area where the back of the foot is located; a heel guide (heel counter shown in Figures 1 and 2) for the heel provided in the upper part; the heel guide located in a second area where the heel is located; the heel guide is such that the Achilles tendon of the foot is free (heel counter supports the heel bone but not above it as shown); the contraction in the outsole is in a third area between the

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forefoot and the back of the foot (see Figure 3); the outsole has a connecting area adjacent the contraction (that between the two contractions shown in Figure 3); the connecting area has a flexibility such that a torsion of a forefoot with respect to the back of the foot is impeded as little as possible; the shoe is for small children (children can use the shoe); the contraction is on both the outside and the inside of the shoe (see Figure 3); the outsole has a thickness that is the thickness being reduced to a minimum thickness required by conditions for manufacturing (the thickness of the sole can meet conditions for manufacturing, otherwise would not be made); the outsole is provided with a heel in the first area (see Figures 1 and 2), the outsole has a connecting area adjacent the contraction that minimizes torsion of the forefoot with respect to the back of the foot (inasmuch as that which is shown by the applicant). Decathlon '698 does not disclose or teach the heel guide having a heel plate. Kiyosawa '301 teaches that a shoe can have a heel counter attached to it to aid in supporting the heel of the user. The heel counter contains a heel plate 1 and 2, which aid in balancing the user's heel. Therefore, it would have been obvious, in view of Kiyosawa '301, to make the heel counter of Decathlon '698 (shown in Figures 1 and 2) out of a hard elastic heel plate, as taught by Kiyosawa '301, to aid in

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balancing the heel of the user during use to aid in preventing pronation or supination.

3. Claims 15, 17, 19 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 11 above in view of DuFour 5,024,007. The references as applied to claim 11 above disclose all the limitations of the claims as noted above except for the outsole having a profiling, the profiling for a great flexibility of the outsole with regard to the heel-to-toe motion of the foot; the profiling having one of a parallel grooves and ray-shaped grooves; the grooves extending at least partially over a width of the shoe, and the profiling being made up of at least two materials having different elasticity. DuFour '007 teaches that the forefoot area of the sole of a shoe can have profiling made up of grooves and material filled within the grooves to aid in flexibility and gripping of the sole to the contact surface. DuFour '007 also teaches that the grooves can be parallel (see Figure 1) and extend at least partially over a width of the sole of the shoe and made up of two materials (A and B), the materials having a different elasticity (col. 2, lines 56-68). Therefore, it would have been obvious to make a profile, such as that shown in DuFour '007, on the sole of the references as applied to claim

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11 above to aid in making the sole flexible as well as still allowing grip, as taught by DuFour '007.

4. Claims 18 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 17 above in view of the French reference to Scop Minibel Sa Societe Anonyme 2,739,533 (Scop '533). The references as applied to claim 17 above disclose all the limitations of the claims except for the grooves extending over the entire width of the shoe. Scop '533 teaches that grooves 5 made in the forefoot of the shoe sole for flexibility of the sole can extend the entire width of the shoe to allow the sole to flex with the normal flexing of the user's foot. Therefore, it would have been obvious, in view of Scop '533, to make the grooves of the references as applied to claim 17 above cross the entire shoe to aid in flexing the sole with the normal flexing of the user's foot.

#### ***Response to Arguments***

1. Applicant's arguments filed April 23, 2003 have been fully considered but they are not persuasive. Applicant argues that the heel guide of Kiyosawa is not provided in the upper part as required by the claims. This argument is not clearly understood. Looking at Figure 1 of Kiyosawa, it is clearly

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shown that the heel guide is provided in the upper part of the shoe, i.e. that which is located above the outsole of the shoe. Comparing this Figure of Kiyosawa with Figure 2 of the instant application, it can clearly be seen that Kiyosawa meets this limitation in as much as that which is shown by the applicant. With regards to applicant's argument that the Examiner should not use the claims of the instant application as an instruction manual to find appropriate prior art that might render the claims obvious, this argument is not clearly understood. A counter is shown on the shoe of Decathlon in Figure 1, therefore, the use of a counter in this shoe is taught by Decathlon, but the way to use the counter is taught by Kiyosawa, thereby rendering it use obvious. Applicant argues that the instant application specification teaches that it is the combination of an increased rotational mobility in the heel and part of the sole with respect to the forward part of the sole, together with a zone of higher flexibility in the ball of the foot are of the front of the foot that promotes the physiological heel to toe motion of the foot. This argument is not clearly understood. The claims are given their broadest reasonable interpretation and limitations from the specification are not read into the claims. Therefore, it is not clear as to what the applicant is arguing with respect to the claim

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limitations. With respect to applicant's argument that DuFour has notches not grooves, this argument is not clearly understood. A notch that extends a long a length meets the definition of a groove and therefore, the notches of DuFour meets the claimed limitation of grooves.

### ***Conclusion***

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining



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groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D. Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Monday-Thursday, 6:00 am until 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Informal Fax for 3728	(703) 308-7769

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	<a href="http://www.uspto.gov/">http://www.uspto.gov/</a>

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A handwritten signature in black ink, appearing to read "Anthony D. Stashick". The signature is fluid and cursive, with the first name "Anthony" and last name "Stashick" clearly distinguishable.

Anthony D. Stashick  
Primary Examiner  
Art Unit 3728

ADS

July 11, 2003